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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID L. GILMOUR, HUA-WEN WANG, and  
JONATHAN M. GOLDBERG

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Appeal 2010-008132  
Application 09/703,189  
Technology Center 2400

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*Before* JOSEPH L. DIXON, THU A. DANG, and JAMES R. HUGHES,  
*Administrative Patent Judges.*

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

## I. STATEMENT OF THE CASE

Appellants appeal from the Examiner's final rejection of claims 1-13, 27, and 28 under 35 U.S.C. § 134(a) (2002). (Amended App. Br. 2.) Claims 14-26 have been canceled. (*Id.*) We have jurisdiction under 35 U.S.C. § 6(b)(2002).

We reverse and enter a new ground of rejection.

### A. INVENTION

Appellants' invention relates generally to the field of knowledge management and, more specifically, to addressing a communication for transmission over a computer network based on the content of the communication (Spec. 2, ll. 13-16).

### B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method of addressing a communication for transmission over a network, the method including:

accessing a descriptive profile of a potential recipient of the communication;

identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and

presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the

sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.

### C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Herz et al.            US 5,835,087            Nov. 10, 1998

Claims 1-13, 27, and 28 stand rejected under 35 U.S.C. § 102(e) as anticipated by the teachings of Herz.

### II. ISSUE

Have Appellants shown that the Examiner erred in finding that Herz teaches “presenting the suggested recipient to a sender of the communication . . . after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient” (claim 1, emphasis added).

### III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

*Herz*

1. Herz discloses a method for identifying “target objects” that may be of interest to a user (col. 4, ll. 37-43), wherein the target objects may be messages posted to a newsgroup (col. 74, ll. 23-27), documents or news articles previously posted to bulletin boards (col. 73, ll. 39-44; col. 78, ll. 47-65), or other users with common interests (col. 73, ll. 47-56).
2. A “target profile interest summary” for each user and a “target profile” for all of the target objects are composed (col. 1, ll. 19-28; col. 74, ll. 23-27).
3. Target objects that a user might be interested in are identified by comparing the contents of the user’s target profile interest summary with the contents of the target object’s target profile (col. 1, ll. 28-35; col. 73, ll. 51-56; col. 74, l. 66 to col. 75, l. 14).
4. An electronic mailing list of designated recipients who might be interested in a target object is generated based on the comparison, and a system generated introductory email is sent to the recipients inviting them to view the object (col. 73, ll. 51-56; col. 74, ll. 43-55).

#### IV. ANALYSIS

Appellants argue that “Herz fails to anticipate the present invention” (Amended App. Br. 5) because Herz does not disclose or even suggest “presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient, after the sender has composed a draft of

the communication and before transmission of the communication to an actual recipient” (Amended App. Br. 8-9, emphasis omitted, citing claim 1). Though the Examiner finds that Herz discloses such limitations (Supplemental Ans. 12), we agree with Appellants and find no teaching of the disputed limitations in the sections of Herz relied upon by the Examiner.

The sections of Herz relied upon by the Examiner disclose identifying a target object that is an article or a discussion thread on a message board, wherein a list of potential recipients is generated as an attachment to a system generated email to be sent to users to invite the users to view the article or thread (FF 1-4). However, we find that such posting of the article or thread for viewing by the potential recipients does not comprise presenting the suggested recipient “to a sender” of the article or thread, as required by claim 1. Further, we find that such posting also does not comprise presenting the suggested recipient “before transmission of the communication” to an actual recipient, as required in claim 1, since the article or thread is already posted. Additionally, although Herz discloses that an introductory email is sent to the various users (FF 4), we find that the introductory email does not comprise the “communication” having content is used to identify “the potential recipient” as required in claim 1.

Similarly, although Herz also discloses that the “target object” maybe other users (FF 1), wherein a list of potential recipients is identified based on comparing user profiles to each other (FF 3) and an introductory email is sent to the recipients to invite them to contact one another (FF 4), we find such introductory email also does not comprise a “communication” having

content used to identify “the potential recipient” as required in claim 1. Furthermore, we find that such sending of the email does not comprise presenting the suggested recipient “to a sender” of the email, as required by claim 1. Additionally, although the email presents a list of suggested recipients, we find the email does not present the suggested recipients to the sender of the email “after the sender has composed a draft,” as required in claim 1, since the list of suggested recipients is identified before a draft of the email is composed.

Accordingly, we find that Appellants have shown that the Examiner erred in rejecting claim 1 under over Herz. Further, independent claims 27 and 28 having similar claim language and claims 2-13 depending from claim 1, stand with claim 1.

## V. NEW GROUND OF REJECTION

As a new ground of rejection, we reject claim 1 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. We note that claim 1, given its broadest reasonable interpretation, does not require computer or machine implementation. Claim 1 is not directed to a machine, manufacture, or composition of matter. Accordingly, the issue is whether this claim, which covers a method for addressing a communication, involves a new and useful “process,” and thus, recites patentable subject matter under 35 U.S.C. § 101. Giving the claim limitations their broadest reasonable interpretation, we conclude that claim 1 is unpatentable under 35 U.S.C. § 101 because it seeks to patent a mental process.

Considering the language of representative claim 1 as a whole, we find that the process of the claim can be performed mentally, verbally or without a machine. In particular, our reviewing court guides that a claim is drawn to an unpatentable abstract idea when the method steps can be performed in the human mind, or by using a pen and paper. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372-73 (Fed. Cir. 2011). Here, we conclude that the scope of claim 1's method steps cover functions that can be performed in the human mind, or by a human using a pen and paper. That is, representative claim 1 simply recites the steps of: (1) "accessing a descriptive profile" in an undisclosed manner; (2) "identifying the potential recipient ... based on an evaluation of a correspondence" in an undisclosed manner; and, (3) "presenting the suggested recipient to a sender of the communication" in an undisclosed manner. Such "accessing," "identifying" and "presenting" steps may be performed without a machine by a human either in the mind or using a pen and paper.

For the foregoing reasons, claim 1 fails to recite statutory subject matter under 35 U.S.C. § 101. While we have not rejected every claim under our discretionary authority under 37 C.F.R. 41.50(b), we emphasize that our decision does not mean the remaining claims are directed to patent eligible subject matter. Rather, we merely leave the determination of these claims to the Examiner. *See* MPEP § 1213.02.



## VI. CONCLUSION AND DECISION

The Examiner's decision rejecting claims 1-13, 27, and 28 under 35 U.S.C. § 102(e) is reversed. Moreover, we have entered a new ground of rejection under 37 C.F.R. § 41.50(b) for claim 1 as failing to recite statutory subject matter under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). That section provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

Section 41.50(b) also provides that the Appellants:

[W]ithin two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED  
37 C.F.R. § 41.50(b)